corresponding information from said user transaction records, **wherein said user transaction records include transation group records for transaction groups of select d transactions which were paid or deposited together, each transaction group record including a transaction identifier, a transaction date, a transaction description, and a transaction amount for each transaction within a plurality of transactions, wherein transaction group records are compared as a single transaction to said information regarding said account**;

determining matches between said account information and said user transaction records at said user unit;

identifying transaction groups for which a match is determined; and

altering a state associated with user transaction records for individual transactions within said transactions groups.

REMARKS

Claims 1-29 are pending in the present application. Claims 1-2, 8-9, 15-16, 25, and 26 were amended. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 102 (Anticipation)

Claims 1-5, 7-12, 14-19, 21-26 and 28-29 were rejected under 35 U.S.C. § 102 as being anticipated by *Morgan et al*. This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The claims have been amended to clarify that the present invention relates to financial transactions involving transfer of

funds from one entity or account to another, and not merely to budget items as disclosed in *Morgan et al*. Accordingly, the claims have been amended to recite that the transaction groups or transaction group records include a transaction identifier, a transaction date, a transaction description, and a transaction amount for each transaction within the group. Such a feature is not shown or suggested in *Morgan et al*, which relates only to cost reporting. *Morgan et al* teaches associating related budget or cost items, and providing details upon demand.

The claims have also been amended to clarify that the transaction groups are selected on the basis of transactions which are paid or deposited together. Such a feature is not shown or suggested by *Morgan et al*.

Therefore, the rejection of claims 1-5, 7-12, 14-19, 21-26 and 28-29 under 35 U.S.C. § 102 has been overcome.

II. 35 U.S.C. § 103 (Obviousness)

Claims 6, 13 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Morgan et al* in view of *Marks*. This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to

grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As noted above, the amended claims include features not shown or suggested by the cited references. Neither *Morgan et al* nor *Marks* teach or suggest the feature of grouping selected transactions which were paid or deposited together such that the transaction group may be selectively treated as a single transaction or as the individual transactions within the group. Similarly, neither reference teaches or suggests grouping transactions including a transaction identifier, transaction date, transaction description, and transaction amount for each transaction within the group.

Therefore, the rejection of claims 6, 13 and 20 under 35 U.S.C. § 103 has been overcome.

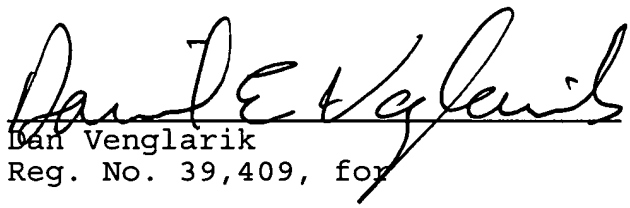
III. Conclusion

It is respectfully urged that the subject application is patentable over *Morgan et al* and *Marks* and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if, in the opinion of the Examiner, such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: July 6, 1999

Respectfully submitted,



Dan Venglarik
Reg. No. 39,409, for

FELSMAN, BRADLEY, VADEN,
GUNTER & DILLON, LLP
201 Main Street Suite 1600
Fort Worth, TX 76102
(817) 332-8143

ATTORNEY FOR APPLICANTS